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## **REMARKS**

### **I. Petition for extension of time**

Applicants herewith petition the Commissioner for Patents to extend the time for response to the Office Action mailed February 28, 2008 for three months from May 28, 2008 to August 28, 2008. Authorization is given to charge the extension of time fee of \$525.00 (37 C.F.R. §1.136 and §1.17) to Deposit Account No. 23-1703. Any deficiency or overpayment in connection with this communication should be charged or credited to the above numbered deposit account.

### **II. Restriction requirement**

Restriction to one of the following Groups of claims is required under 35 U.S.C. §121:

I. claims 1-24, drawn to a method of preparing an imaged composite, classified in class 427, subclass 407.1, and

II. claim 25, drawn to an article, classified in class 428, subclass 411.1+.

Applicant confirms that Group I was elected with traverse during a telephone discussion with the Examiner on January 30, 2008. All of claims 1-24 read on the elected invention.

### **III. Traversal of the restriction requirement**

Logic dictates that prior art which is material to the patentability of the claimed process (Group I) will also be material to the patentability of the products made by that process (Group II). A thorough prior art search that is complete with regard to Group I should uncover prior art that is also material to Group II. Accordingly, Applicant submits that it would not be an undue burden on the Examiner to examine Groups I and II in the instant application.

For all of the foregoing reasons, rejoinder of Groups I and II for examination in a single application will demonstrate the Office's commitment to the economic expenditure of resources and efficient examination of applications. A contrary decision will suggest that the Office is more interested in generating revenue at the expense of efficiency and the judicious utilization of administrative resources.

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**IV. Claim Amendments**

Claim 1 has been amended to incorporate the limitations of original claim 5 which has been canceled. Claims 6 and 7 have also been canceled. Claim 15 has been amended as suggested by the Examiner, thus rendering moot the claim objection.

**V. Claim rejections - 35 U.S.C. §112, second paragraph**

Claims 6 and 7 are rejected under 35 U.S.C. §112, second paragraph, as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. Withdrawal of the §112 rejection is requested in view of the cancellation of claims 6 and 7.

**VI. Claim rejections - 35 U.S.C. §102**

Claims 1-4, 8-10 and 12-18 are rejected under 35 U.S.C. §102(b) as being anticipated by US 6,340,504 to Neumann ("Neumann I"). Claims 1-4, 8-10, 12 and 19 are rejected under 35 U.S.C. §102(b) as being anticipated by US 6,284,327 to Neumann ("Neumann II"). Claims 1, 7-9, 12, 13, 16, 17, 20, 21 and 23 are rejected under 35 U.S.C. §102(e) as being anticipated by US 6,596,116 to Macedo ("Macedo").

Claim 1 has been amended to recite the embodiment of claim 5, now canceled, which was not rejected under §102 in view of Neumann I, Neumann II or Macedo. Therefore, for the same reasons, amended claim 1 and the claims dependent thereon are deemed novel.

Withdrawal of the §102 rejections of record are requested.

**VII. Claim rejections - 35 U.S.C. §103**

Claims 7 and 11 are rejected under 35 U.S.C. §103(a) as being unpatentable in view of Neumann I and Neumann II. Claims 20-24 are rejected under 35 U.S.C. §103(a) as being unpatentable in view of Neumann I and Neumann II, each in combination with Macedo. Claims 4, 10, 11, 22 and 24 are rejected under 35 U.S.C. §103(a) as being unpatentable in view of Macedo. Claims 5 and 6 are rejected under 35 U.S.C. §103(a) as being unpatentable in view of Macedo in combination with US 4,908,345 to Egashira ("Egashira").

Applicant submits that the claim amendments render moot all of the §103 rejections of record except for the rejection of claims 5 and 6 in view of Macedo in combination with

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Egashira. Claim 1 was amended to incorporate the limitations of claim 5 which has been canceled. Claim 6 has been canceled. For the following reasons, Applicant submits that the claimed invention as defined by amended claim 1 is patentable over the combination of Macedo and Egashira.

The Examiner alleges that Macedo teaches a process in which a cellulose web is impregnated with a resin material and then dried to cure the resin, followed by sublimation printing. The Examiner acknowledges that Macedo does not expressly teach the coating material comprising an unsaturated polyester resin, styrene monomer and methyl methacrylate originally set forth in claim 5 and now incorporated into claim 1. (Office Action at p. 17.)

For this reason, the Examiner relies on Egashira. Specifically, the Examiner alleges that Egashira teaches a sublimatable dye receiving layer prepared from a composition comprising the elements recited in claims 5 and 6. The Examiner also alleges that it would have been obvious at the time the claimed invention was made to modify Macedo to use the polyester compositions set forth in Egashira to arrive at the claimed invention. According to the Examiner, the person of ordinary skill would have been motivated to do so by the desire and expectation of providing a layer having improved dyeability and wear.

Applicant respectfully submits that the claimed invention represents a superior result and advantageous improvement over the cited combination of references which, in any event, does not suggest the claimed invention. Furthermore, the modification of Macedo to allegedly render the claimed invention obvious in view of the cited combination of references defeats the intent, purpose and function of Macedo. As such, a *prima facie* case of obviousness has not been established.

In accordance with the claimed invention, the gel coat composition is applied to the surface of a substrate comprising a composite material. Paragraph [0017] of the published patent application no. US 2005/0227006 provides that a "substrate for the present invention will typically be a composite material, such as a filler suspended in a matrix binder". Without limitations, examples of fillers are fibers, particulates, fabrics and mixtures thereof, and examples of matrices are canvas, ceramic, cement, glass, metal, plastic and wood. An example of a composite material is a polyester resin matrix reinforced with glass fibers. Additional

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examples of composite materials for use in the claimed invention are synthetic marbles and gypsum cements.

Advantageously, as stated in [0010] of the published patent application, the use of composite materials renders the claimed method "green" and environmentally friendly by incorporating waste products, e.g., coffee grounds and plant fibers, or manufacturing waste materials into the composite during its manufacture. After application of the gel coat composition to the composite material surface, the gel coat composition is cured and a sublimatable dye is transferred to the cured gel coat composition to obtain the imaged composite.

The purpose and intent of Macedo is to manufacture decorative thermofused laminates which store easily and cheaply as compact rolls and which can be easily bound to substrates. (See col. 2, lines 3-7). To this purpose, a cellulose web material impregnated with a thermosetting resin is applied to a backer sheet to form a pre-laminate. A release sheet is applied to the exposed surface of cellulose web material and a transfer sheet bearing a decorative sublimation dye design is applied to the exposed surface of the release film. Upon application of heat and pressure, the cellulose web material seeps into the pores of the backer sheet to form a thermofused continuous laminate and the design on the transfer sheet penetrates the thermofused continuous laminate. The release and transfer sheets are separated from the thermofused continuous laminate showing the transferred design. The decorative laminates produced in accordance with Macedo are then stored and removed from storage at a future date to be bound to a substrate with an adhesive. (See col. 8, lines 16-34).

In contrast to Macedo, the claimed invention provides an advantageous and economical method for transferring a sublimatable image onto the surface of a composite material without the expense and labor associated with (1) additional materials such as backer and release sheets, (2) storage and (3) a post-production step of adhering the decorative laminate to a substrate.

Furthermore, to be able to manufacture rolls of a decorative thermofused laminates which can be stored for future use, Macedo purposefully uses a cellulose web material. Again, in contrast to Macedo, the claimed invention uses a composite material such as a filler suspended in a binder matrix. Bathroom shower floor tiles are one example of a finished composite product prepared in accordance with the claimed method. (See the published patent application at [0011])

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and [0034]). Therefore, the cellulose web material employed by Macedo does not suggest the composite material of the claimed invention.

The Examiner relies on Egashira for the disclosure of a dye receiving sheet. Applicant submits that the combination of Macedo and Egashira does not suggest the claimed invention. Moreover, the modification of Macedo to allegedly render the claimed invention obvious in view of the cited combination of references would defeat the intent, purpose and function of Macedo.

In view of *KSR International Co. v. Teleflex Inc.*, 550 U.S. \_\_\_, 82 U.S.P.Q. 2d 1385 (2007), the Office issued Examination Guidelines for making an obviousness rejection under 35 U.S.C. §103. (Fed. Reg., Vol. 72, No. 195, October 10, 2007, pp. 57526-57535). Subsection A of the Examination Guidelines is directed to the combination of prior art elements and provides in the middle column on page 57529 that prior art elements may be combined as claimed by known methods "*with no change in their respective functions*". (Emphasis added). In this regard, the Examination Guidelines at Section A quotes the Supreme Court:

"When the prior art teaches away from combining certain known elements, discovery of successful means of combining them is more likely to be nonobvious". *KSR*, 550 U.S. at \_\_\_, 82 USPQ 2d at 1395.

Subsection A of the Examination Guidelines is consistent with Sections V and VI of M.P.E.P. §2143.01 (8 Ed.) which provide the following:

**V. THE PROPOSED MODIFICATION CANNOT RENDER THE PRIOR ART UNSATISFACTORY FOR ITS INTENDED PURPOSE**

If proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification...

**VI. THE PROPOSED MODIFICATION CANNOT CHANGE THE PRINCIPLE OF OPERATION OF A REFERENCE**

If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious...

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As previously stated, the primary reference to Macedo discloses the imaging of a thermofused continuous laminate comprising a cellulose web material, storage of the decorative laminates, removal and subsequent application of the decorative laminates to a substrate with an adhesive. The person of ordinary skill would not have been motivated to modify Macedo in view of Egashira to arrive at a "green" manufacturing process, as claimed, of directly transferring a sublimatable image to a composite material such as a filler suspended in a matrix binder.

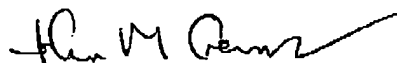
The combination of Macedo and Egashira contravenes *KSR*, Section A of the Examination Guidelines and Sections V/VI of M.P.E.P §21403.01. There is no motivation to combine them when the proposed combination would destroy intent and change the principle of the primary reference to Macedo. For all of the foregoing reasons, a *prima facie* case of obviousness has not been established. Withdrawal of the §103 rejections of record is requested.

#### CONCLUSION

In view of the claim amendments and remarks herein, the application is in condition for allowance. Authorization is hereby given to charge any fee due in connection with this communication to Deposit Account No. 23-1703.

Dated: August 14, 2008

Respectfully submitted,



John M. Genova  
Reg. No. 32,224

Customer No. 07470  
Direct Line: (212) 819-8832